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United States Court of Appeals for the Federal Circuit

01-1155

(Serial No. 75/339,270)

IN RE AMEROPE ENTERPRISES, INC.

DECIDED: December 13, 2001

Before LOURIE, CLEVINGER and GAJARSA, Circuit Judges.

CLEVINGER, Circuit Judge.

Amerope Enterprises, Inc. ("Amerope") appeals the decision of the Trademark Trial and Appeal Board ("Board"), denying registration of the mark SAF-T-LITE for laminated leaded glass panels and panes. We find the Board's findings of fact are supported by substantial evidence, and we agree with the Board's conclusion that Amerope's mark so resembles the previously registered mark SAFTI-LITE as to be likely to cause confusion with the previously registered mark. We therefore affirm the Board's decision.

Appellant Amerope seeks to register the mark SAF-T-LITE for goods it describes in its application as "laminated leaded glass panels or panes." Amerope's application was rejected by the examining attorney under 15 U.S.C. § 1052(d), which forbids registration of a mark so resembling a previously registered mark as to be likely to cause confusion when used on or in connection with the goods of the applicant. The examining attorney rejected Amerope's application as likely to cause confusion with the mark SAFTI-LITE, a mark registered for "fire and safety rated glass" as Registration No. 2,089,494.

Amerope appealed the rejection to the Board. The Board found that the marks SAF-T-LITE and SAFTI-LITE were highly similar. The Board further found that while not identical, Amerope's goods and the goods described in the prior registration are sufficiently related that purchasers encountering goods bearing such similar marks would mistakenly believe that the goods originated from or were in some way associated with the same producer. Since neither Amerope's application nor the prior registration expressed any limitation as to the scope of the goods, differences in trade channels, or classes of purchasers, the Board found that the substantial similarity between the marks and the relatedness of the goods outweighed any other factors that might tend to differentiate the marks. Concluding that Amerope's proposed mark was likely to cause confusion with the prior registration when used in connection with laminated leaded glass panels or panes, the Board affirmed the examining attorney's rejection. Amerope brings this appeal of the Board's decision pursuant to 15 U.S.C. § 1071(a).

II

Whether a likelihood of confusion exists is a question of law, based on underlying factual determinations. Lloyd's Food Prods., Inc. v. Eli's, Inc., 987 F.2d 766, 767, 25 USPQ2d 2027, 2028-9 (Fed. Cir. 1993). While we review the Board's ultimate legal conclusion de novo, In re Int'l Flavors & Fragrances, Inc., 183 F.3d 1361, 1365, 51 USPQ2d 1513, 1515 (Fed. Cir. 1999), we review the Board's underlying findings of fact under the substantial evidence standard. On-Line Careline, Inc. v. America Online, Inc., 229 F.3d 1080, 1084-1086, 56 USPQ2d 1471, 1474-5 (Fed. Cir. 2000). Thus, we ask whether a reasonable person might find that the evidentiary record supports the Board's conclusion. Id. at 1085, 56 USPQ2d at 1475. While substantial evidence review requires taking into account evidence that detracts from an agency's finding as well as evidence that justifies it, the possibility that divergent conclusions may be drawn from the same record will not render the Board's finding unsupported by substantial evidence. Id. at 1086.

In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), set forth 13 factors to be considered in determining whether an applicant's mark is likely to cause confusion with a prior registration. These factors are: (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) the similarity or dissimilarity and nature of the goods described in the application or registration of the mark, or in connection with which a prior mark is in use; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and the buyers to whom sales are made; (5) the fame of the prior mark; (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and the conditions under which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used; (10) the market interface between the applicant and the owner of a prior mark; (11) the extent to which the

applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion; and (13) any other established fact probative of the effect of use. Id. at 1361, 177 USPQ at 567.

Not all of the DuPont factors may be relevant or of equal weight in a given case. While DuPont mandates that all of the factors "must be considered" when they are of record, a Board decision is not made erroneous by focusing on the most relevant and important factors and ignoring others. In re Dixie Restaurants, Inc., 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). Moreover, if there is any doubt as to whether there is a likelihood of confusion between the application and a prior registration, that doubt must be resolved in favor of the prior registration and the application denied. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

III

Amerope does not dispute the Board's finding that its SAF-T-LITE mark is highly similar to the previously registered SAFTI-LITE mark. Instead, Amerope urges us to find that the Board's findings under the other DuPont factors were not supported by substantial evidence in three respects. First, Amerope argues that the Board erred in finding similarity of goods between Amerope's "laminated leaded glass panels or panes" and the prior registrant's "fire and safety rated glass." Second, Amerope argues that the Board ignored differences in the prospective purchasers and channels of trade between Amerope's product and the prior registration. Third, Amerope argues that the Board improperly dismissed evidence of similar third-party registrations tending to show that similar marks are in use in the marketplace. We address each argument in turn.

A

In comparing Amerope's goods with those of the prior registrant, the Board characterized the prior registrant's goods as "safety rated glass," and believed that this identification was broad enough to include the type of safety lead glass sold by Amerope. The Board therefore found that Amerope's goods were similar to the prior registrant's.

Amerope makes two arguments that the Board erred in its finding. First, Amerope argues that the Board erroneously characterized the prior registrant's goods as "safety rated glass," when in fact the prior registration describes "fire and safety rated glass." According to Amerope, the fact that the prior registration reads "fire and safety rated glass" means that the registered goods must be rated for both fire and safety. Since its own goods have no fireproof qualities, Amerope urges that its goods are dissimilar from the registrant's.

We disagree with Amerope's argument that by "grammatical necessity," the previously registered goods must be rated for both fire and safety. "Fire and safety rated glass" could describe a single kind of glass rated for fire and safety, or a product line comprising "fire rated glass" and "safety rated glass." Given that neither Amerope's application nor the prior registration recites a field of use restriction, and that doubts are resolved in favor of the prior registrant, the Board's construction is a permissible one.

However, even if we assume that the previously registered goods are restricted to glass rated for both fire and safety, we cannot say that the Board's finding of similarity is unsupported by substantial evidence. The inquiry under likelihood of confusion is whether the goods are

similar, not identical. As the Board correctly noted, the issue is not primarily whether the goods will be confused with each other, but rather whether the public will be confused about their source. Therefore, "the law has long protected the legitimate interests of trademark owners and consumers from confusion among noncompetitive, but related, products bearing confusingly similar marks." Safety-Kleen Corp. v. Dresser Indus., Inc., 518 F.2d 1399, 1404, 186 USPQ 476, 480 (CCPA 1975). If fire rated glass and other kinds of safety glass are sufficiently related that a consumer might think that similarly named products emanate from a single source, a finding of similar goods is proper. Given that there is no evidence in the record suggesting otherwise, the Board's finding of similarity between Amerope's goods and those of the prior registrant is supported by substantial evidence.

Amerope also attempts to distinguish its goods from the previously registered "fire and safety rated glass" by arguing that the description of its goods in its amended application, "laminated leaded glass panels or panes," does not even connote "safety" unless read in conjunction with Amerope's sales brochure. We note some tension between this position and Amerope's subsequent assertion that "leaded" connotes protection from the danger of harmful radiation in the medical field. More importantly, this argument demands ignorance of the fact that Amerope seeks to register the mark SAF-T-LITE. Since we perceive some possibility that a connotation of "safety" could be drawn from the term SAF-T-LITE, the Board's finding that Amerope's mark might connote "safety" when used in connection with laminated leaded glass panels or panes is supported by substantial evidence.

B

Amerope next argues that the Board improperly resolved against Amerope the doubts raised by Amerope's arguments of sophisticated purchasers and different channels of trade. Given that that any "doubts about likelihood of confusion, etc., under § 2(d) must be resolved against applicant," In re Hyper Shoppes, 837 F.2d at 464-465, 6 USPQ2d at 1026 (emphasis added), Amerope sets a heavy burden for itself by portraying the Board's alleged errors in these terms.

Amerope asserts that radiation-blocking glass is purchased by medical professionals, while fire and safety rated glass is purchased by architects and engineers. According to Amerope, the sophistication of these different classes of purchasers, and the different channels of trade they patronize, would alleviate the possibility that its mark would cause confusion when used in connection with laminated leaded glass panels or panes. However, Amerope offers no evidence to support its assertions. Where neither the application nor the registration restricts the class of purchasers or channels of trade, it is presumed that the goods move in all normal channels of trade and are available to all classes of purchasers. TMEP § 1207.01(a)(iii). In the absence of any evidence to overcome this presumption, the Board was justified in according little weight to these arguments.

Moreover, to the extent that Amerope seeks to limit the scope of its goods or the goods of the prior registrant by evidence of marketplace conditions, it is well established that both the application and the prior registration are evaluated based on the description of the goods or services found in the application and registration documents themselves, rather than on other evidence. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Assoc., 811 F.2d 1490, 1491, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). In particular, we have said of the DuPont factors asserted by Amerope:

The authority is legion that the question of registrability of an applicant's

mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

Octocom Sys., Inc. v. Houston Computer Servs., Inc., 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Thus, while extrinsic evidence may bear on the likelihood of confusion under the DuPont factors, the scope of the goods or services identified by the application or registration may not be limited by extrinsic evidence or argument. See, e.g., In re Bercut-Vandervoort & Co., 229 USPQ 763, 764-765 (TTAB 1986).

The Board is entitled to weigh the DuPont factors differentially according to the facts of each case, In re Dixie Restaurants, 105 F.3d at 1406-1407, 41 USPQ2d at 1533, and we agree with its conclusion that Amerope's speculative arguments concerning channels of trade and the sophistication of purchasers are outweighed by the similarity between the marks and the relatedness of the goods.

C

Finally, Amerope argues that the Board ignored the existence of third-party registration SAFELITE, for automobile glass products, in its determination. We note at the outset that Amerope's SAF-T-LITE mark is more similar phonetically to the prior registration SAFTI-LITE than is the third party SAFELITE registration. This difference limits the probative value of the SAFELITE mark in assessing confusion between SAF-T-LITE and SAFTI-LITE. But more importantly, the DuPont analysis considers similar marks in use on similar goods, not similar marks registered for similar goods. Third-party registrations alone carry little weight as evidence of use in a likelihood of confusion determination. See Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 917, 189 USPQ 693, 694 (CCPA 1976); In re Comexa Ltda., 60 USPQ2d 1118, 1120 (TTAB 2001). Therefore, the existence of the third-party SAFELITE registration bears little or no relevance to the likelihood of confusion determination.

Amerope repeatedly argues that the existence of similar registered marks means that the prior registration here "should be given a narrow scope of protection" in the likelihood of confusion determination. The scope of "protection" for the registered mark is not at issue in this proceeding; the statutory inquiry under § 1052(d) is whether Amerope's mark, as used in connection with its goods, is likely to cause confusion by virtue of its resemblance to the previously registered mark. To the extent that Amerope is arguing that the scope of goods covered by the registered mark should be limited by the existence of other registrations, its argument must be rejected on the grounds that the registration itself, not third-party registrations, determines the scope of the registration for purposes of assessing similarity of goods. The Board's finding that the third-party registrations are of little probative value in the likelihood of confusion inquiry is supported by substantial evidence.

CONCLUSION

The Board's finding of substantial similarity between the marks and goods of the application and the prior registration is supported by substantial evidence, as is the Board's decision to

accord little weight to the third-party registration and to alleged differences between purchasers and channels of trade. Moreover, the Board applied the proper presumptions in giving the goods an unrestricted scope and resolving doubts in favor of the prior registrant. We find that the Board reached the proper legal conclusion of likelihood of confusion under the DuPont analysis. We therefore affirm the Board's decision to sustain the examining attorney's rejection of the application under 15 U.S.C. § 1052(d).